

Remarks

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, rejected claims 9-13 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. patent 6,420,953 (to Dadafshar) in view of U.S. patent 5,331,536 (to Lane). The Office Action rejected claim 14 as allegedly unpatentable over Dadafshar and Lane in further view of U.S. patent 5,521,573. In view of the foregoing amendments, and at least the reasons that follow, Applicants respectfully traverse the rejections and request withdrawal thereof.

Claim 9 has been amended by adding limitation of a second coil having one terminal grounded (the limitation of previous claim 14). Therefore, Applicants will address the rejection of claim 14, in the context of amended claim 9.

Amended claim 9 recites a filtering induction device comprising a first coil, a second coil, and a core structure, wherein the first coil is used as an inductor and the second coil has one terminal grounded. The first coil has a plurality of circles and the second coil also has a plurality of circles.

In contrast to these claimed features, Dadafshar discloses a multi-layer, multi-functioning printed circuit board including an upper core portion 510, a lower core portion 520, a secondary copper plate 540, and PCB's 525, 530 and 535. Referring to column 4, lines 41-45 and column 9, lines 41-45 of Dadafshar, the first printed circuit board 525 is configured to form a primary winding of a transformer, and the second set of printed circuit boards 530, 535 is configured to form a secondary winding of a transformer. The conductive plate 540 is configured as an output inductor turns. That is, the PCB 525 and the copper plate 540 cannot perform the same function, they cannot be unreasonably combined together as a first coil. Furthermore, and in further contrast to the presently claimed invention, the copper plate 540, the PCB's 525,

530 and 535 are single turned panels, stacking in an offset arrangement. For at least these reasons, the application of Dadafshar to independent claim 9 is misplaced.

With regard to Lane, Lane discloses a low leakage high current transformer including four transformer secondary winding coils 13(column 2, line 36 of the reference), nine primary coils 23, and core elements 24a, 24b. It is noted that the secondary winding coils 13 are configured as a transformer. Additionally, each of the winding coils 13 and primary coils 23 are single turned. In other words, a plurality of single turned coils 13 or 23 completes a single winding. In summary, Dadafshar and Lane do not teach that the first coil is used as an inductor. Dadafshar and Lane do not disclose the "a" coil comprising a plurality of circles. Third, Dadafshar and Lane do not teach that a terminal of the second coil is grounded. For at least these reasons, claim 9 patently defines over the cited art.

As defined in claim 9, one end of the second coil of the present invention is grounded. However, and as admitted by the Office Action, neither Dadafshar nor Lane is not so configured. The Office Action, however applied Inoh as allegedly teaching this feature. Applicants disagree with this combination of Inoh, as Inoh shares no meaningful commonality with Dadafshar and Lane.

In this regard, Applicants' submit that the Office Action has failed to identify a proper basis for combining the Dadafshar, Lane, and Inoh references. For example, in combining Lane with Dadafshar, the Office Action stated only that the combination would have been obvious "for the purpose of reducing leakage inductance." Likewise, when further combining Inoh, the Office Action stated only that the further combination of Inoh would have been obvious "for the purpose of improving high frequency insulating characteristics. This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure. In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a filtering induction device, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may

flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

As amended claim 9 has overcome the rejection, claims 10-13 (which depend from claim 9), overcome the rejections for at least the same reasons.

Newly added claims 15-20 also define over the cited art of record, as independent claim 15 embodies features that are not disclose or suggested in the cited art.

All claims 9-13 and 15-20 are believed to be in condition for allowance, and the Examiner is respectfully requested to pass those claims to issuance. If the Examiner believes a teleconference will expedite the examination of this application, the Examiner is invited to contact the undersigned attorney at 770-933-9500.

No fee is believed to be due in connection with this Amendment and Response to Restriction Requirement. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted,


Daniel R. McClure; Reg. No. 38,962

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500